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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,449	08/28/2000	Piotr Cofta	004770.00589	5441

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BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER
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LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/648,449

Applicant(s)

COFTA, PIOTR

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-11,14-19,23 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) 10,11,14-19 and 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-9,23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



KAMBIZ ZAND  
PRIMARY EXAMINER

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 February 2006 has been entered.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I in the reply filed on 13 April 2006 is acknowledged.

### ***Response to Amendment***

3. The amendment filed 13 February 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: access control to a physical location beyond said control point (from claim 8), and transmittal of the authentication of said control point from the token to the control point (from claim 6).

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

4. Applicant's arguments filed 13 February 2006 have been fully considered but they are not persuasive. Applicant's argument that Geiger does not disclose "receiving at said token an authentication of ... said token" and "transmitting to said control point said authentication of said

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token” is not persuasive because Geiger discloses transmits information that can be used to authenticate the token at an attribute authority (in one example)(Col. 13, lines 26-65). Once authentication of the token and the requested transaction has occurred, a voucher is generated by the authenticating attribute authority (Col. 14, lines 63-64). This voucher can then be transmitted back to the token (Col. 15, lines 6-10), which meets the limitation of receiving at said token an authentication of said token. Once received, the token can transmit the voucher to the next attribute authority in the virtual wireless mall with which the token wishes to do business (Col. 15, lines 9-10), which meets the limitation of transmitting to said control point said authentication of said token.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6, 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 6 recites, “authorizing said action based on authentication of said token and authentication of said control point provided by said token,” which is not supported by the specification in this particular embodiment. This embodiment where the authentications of the

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control point and token are initiated and received at the token does not include the authentication of the control point being sent to the control point by the token.

8. Claim 8 recites, "access control to a physical location beyond said control point," which is not supported by the specification. The specification discloses different control points, but is silent with respect to physical locations beyond the control points.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 4 recites, "said mobile communication device communicates with said token using a wireless communication path," which renders the claim indefinite because the claim from which claim 4 depends (claim 1) requires that "the token is a mobile wireless communication device." Therefore, claim 1 requires the token and the mobile communication device to be the same element, and claim 4 suggests that they are different elements communicating over a wireless communication path. For the purposes of examination, the limitations of claim 4 will be treated in view of claim 1, and the limitations of claim 4 will be met by the disclosure of a token being a wireless communication device.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 4, 6-9, 23, 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Geiger, U.S. Patent No. 6,463,534. Referring to claims 1, 4, Geiger discloses an electronic commerce system within a wireless network domain wherein a mobile client checks the validity of a merchant server with the network upon first use or periodically (Col. 13, lines 13-15), which meets the limitation of obtaining information from said control point by said token, transmitting via said network from said token said information obtained by said control point, said information being transmitting to said network from said token, wherein the token is a mobile wireless communication device. A validation server performs the validity check procedure for mobile client and returns the result (Col. 13, lines 16-19), which meets the limitation receiving at said token an authentication of said control point. Once authenticated the mobile client provides authentication information to the attribute authority in order to authenticate the mobile client (Col. 13, lines 26-65), which meets the limitation of transmitting via said network from said token information regarding said token. Once authentication of the token and the requested transaction has occurred, a voucher is generated by the authenticating attribute authority (Col. 14, lines 63-64). This voucher can then be transmitted back to the token (Col. 15, lines 6-10), which meets the limitation of receiving at said token an authentication of said token. Once received, the token can transmit the voucher to the next attribute authority in the virtual wireless mall with which the token wishes to do business (Col. 15, lines 9-10), which meets the limitation of transmitting to said control point said authentication of said token.

Referring to claim 6, Geiger discloses an electronic commerce system within a wireless network domain wherein a mobile client checks the validity of a merchant server with the network upon first use or periodically (Col. 13, lines 13-15). Once authenticated the mobile client provides authentication information to the attribute authority in order to authenticate the mobile client (Col. 13, lines 26-65). Once authentication of the token and the requested transaction has occurred, a voucher is generated by the authenticating attribute authority (Col. 14, lines 63-64), which meets the limitation of said control point authorizing said action based on authentication of said token and authentication of said control point provided by said token.

Referring to claim 7, Geiger discloses that the transactions are electronic commerce transactions (Col. 1, lines 6-11), which meets the limitation of a financial transaction.

Referring to claim 8, Geiger discloses that the action is user access of software, service or other content item (Abstract) from a merchant within a virtual wireless mall (Col. 15, lines 6-10), which meets the limitation of action comprising access control to a physical location beyond said control point.

Referring to claim 9, Geiger discloses that during the validation of the merchants, the mobile client is notified as to the status of the merchant as a trusted domain member (Col. 13, lines 17-21), which meets the limitation of said authenticating said control point comprises notifying said user whether said control point has authorization for said action.

Referring to claims 23, 29, 30, 32, Geiger discloses an electronic commerce system within a wireless network domain wherein a mobile client checks the validity of a merchant server with the network upon first use or periodically (Col. 13, lines 13-15), which meets the limitation of a wireless communication portion that obtains information regarding said control

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point, the device is a mobile communication device, communication authenticating said control point over said network, said communication portion is temporarily coupled to said device. A validation server performs the validity check procedure for mobile client and returns the result (Col. 13, lines 16-19), which meets the limitation of communicates wirelessly with an external entity to authenticate said control point based on said information. Once authenticated the mobile client provides authentication information to the attribute authority in order to authenticate the mobile client (Col. 13, lines 26-65). Once authentication of the token and the requested transaction has occurred, a voucher is generated by the authenticating attribute authority (Col. 14, lines 63-64), which meets the limitation of authenticating the user to the control point to perform the action using the control point, communication authenticating said user device over said network. This voucher can then be transmitted back to the token (Col. 15, lines 6-10), which meets the limitation of receiving at said token an authentication of said token. Once received, the token can transmit the voucher to the next attribute authority in the virtual wireless mall with which the token wishes to do business (Col. 15, lines 9-10), which meets the limitation of said wireless communication portion configured to transmit authentication of said device to the control point after having been received from said network. The mobile client has a display (Figure 1), which meets the limitation of a user interface portion, coupled to said communication portion, to indicate a result of said authentication of the control point to a user, said user interface notifies said user whether said control point has authorization for said action, said user interface portion comprises a display device.

Referring to claim 27, Geiger discloses that the transactions are electronic commerce transactions (Col. 1, lines 6-11), which meets the limitation of a financial transaction.



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Referring to claim 28, Geiger discloses that the action is user access of software, service or other content item (Abstract), which meets the limitation of action comprising access control.

Referring to claim 31, Geiger discloses that the client device contains a SIM card that contains user and device information (Col. 11, line 64 – Col. 12, line 8), which meets the limitation of a card that connects with said communication portion, said card containing information regarding one of said device and said user.

***Conclusion***

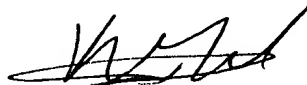
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



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